

II) REMARKS

The following remarks are presented in response to the Office action dated August 14, 2006. The Applicant has amended claims 41 and 69 as explained herein and has also added new dependent claims 97 and 98.

In the Office action, the Examiner has withdrawn the prior rejection of the claims under Tagawa based on the Applicants arguments made in the Response dated May 24, 2006. The Applicant thanks the Examiner for the courtesy of the prior interview in which the Applicant explained its position, which led to the withdrawal of the rejection under Tagawa. Applicant understands that the Examiner felt it necessary to perform a new search of the prior art and welcomes the opportunity to address the current rejection herein. However, the claims have been clear throughout prosecution of this application and had not been amended. Applicant again wishes to point out that “piecemeal examination should be avoided as much as possible” (MPEP 707.07(g)). The examiner should reject each claim on all valid grounds available. *Id.* Applicant therefore respectfully requests the Patent Office to make all possible rejections of the present claims, if any can be made, in any subsequent Office action in order to expedite prosecution.

Claims 41-43, 47, 49, 50, 52-56, 59, 60, 62, 65, 66, 69-72, 75, 77, 78, 80-84, 87, 88, 90, 93 and 94 have been rejected under 35 USC 102(e) as allegedly being anticipated by Narasimhan (US 2003/0009379). Claims 44, 51 and 79 are rejected under 35 USC 103(a) as being unpatentable over Narasimhan. Claims 57, 58, 64, 67, 68, 85, 86, 92, 95 and 96 are rejected under 35 USC 103(a) as being unpatentable over Narasimhan in view of Tagawa. Claim 61, 63 and 89 are rejected under 35 USC 103(a) as being unpatentable over Narasimhan in view of Barnett (USP 6,321,208). Applicant respectfully traverses these rejections since the prior art, alone or in combination, clearly does not teach or render obvious the limitations set forth in the rejected claims.

Applicant's invention provides a system that allows coupon providers to generate packages of one or more offers or coupons to users. A plurality of user profile records

are generated, each of which includes a geographic location associated with a user, which may be, for example, a destination to which the user will travel. The user profile record may also include his or her prior purchases or lifestyle data, travel preferences, purpose of travel, and the time frame for travel (which may be entered by the user or acquired from various preexisting databases). The system analyzes this profile information in an intelligent and proactive manner and then generates a personalized collection of one or more purchase incentive coupons where the offer is valid for that user and only at the geographic location(s) associated with the user, for the time frame specified or as set forth in the user's profile. In addition to matching coupon offers to a certain user profile data record (i.e. finding relevant offers for a given user), the system will match user profile records to a certain coupon offer (i.e. find relevant users for a given coupon offer).

The present invention optionally provides for a registration process, wherein the user may enter his leisure and business related interests into a user profile. The user may also indicate the planned itinerary of the trip, including the dates of travel, destination, and mode of travel (this may also be obtained from preexisting databases). After registration, the system utilizes an intelligent manner of retrieving or creating offers (i.e. coupons) from its memory that correlate to various factors in the user profile. Thus, offers would be extracted from memory that provide discounts at stores at the location of travel, and only for the duration of time that the traveler will be staying at that location. The system will also utilize its intelligence and predictive analysis to match the offers to the previously stored traveler profile; for example, a business traveler might be provided with coupons for use at a business center (e.g. copy store), while a leisure traveler might only get coupons for use at a theme park at that location. Optionally, the terms of the coupon offers may be modified by the issuer directly with the coupon server prior to distribution of the coupons.

Thus, claim 41 recites a coupon generation and distribution system that has a centrally located coupon server computer and a plurality of member computers interconnected to a computer network. Each of the member computers is associated with a member of the system (members may include a user/traveler, a travel agent, a coupon offering entity, an airline, cruise line, restaurant, retail shop, manufacturer, duty-free shop, etc.). The

coupon offering entities supply coupon offers (which provide an incentive to purchase an item) to the centrally located coupon server computer, which then assembles the coupon offers into a repository of coupon offers available for generation into coupons for dissemination to the users. The coupon server computer has means for storing a plurality of user profile data records, each having user profile data including an identification of a user and at least one geographic location (e.g. a destination or point of redemption) associated with that user. The coupon server also has means for analyzing a given user profile data record with respect to all of the coupon offers in the repository (and/or analyzing a given coupon offer with respect to a plurality of the user profile data records) and for generating one or more coupons from the coupon offers based on the analysis, wherein the coupons are limited to use by the user for items at the geographic location associated with the user (e.g. his or her travel destination or point of redemption). The coupon server computer also has means for distributing the generated coupon(s) for use by the user in purchasing the item.

Although Applicant firmly believes that the cited prior art does not teach the invention of the Applicant as claimed, the Applicant has amended independent claims 41 and 69 to clearly distinguish the invention from this prior art. Claims 41 and 69 have been amended to clarify that the generated coupon(s) are distributed to the user for subsequent redemption when purchasing the item associated with the coupon from the coupon offering entity at the geographic location associated with the user, whereby the coupon offering entity is provided with the identification of the user redeeming the coupon redeeming the coupon. Since claims 41 and 69 as previously presented clearly specified that the coupon(s) generated are limited to use by the user identified in the user profile data record for items at the geographic location associated with the user, this amendment merely clarifies that the redemption of the coupon will result in the coupon offering entity learning of the identity of the redeeming user due to the fact that the coupon is limited to use by that particular user. Thus, no new matter has been added and the scope of the claim as previously presented remains unchanged.

Notably, the independent claims 41 and 69 are limited to the generated coupons being redeemed for purchasing the item *at the geographic location associated with the user*.

That is, if the user has a geographic location of Orlando, Florida in his profile (such as when he will be traveling to Orlando), then he may be provided with coupons that are redeemable only by him and only in Orlando (the designated “geographic location”). This also is not taught or suggested by the cited references as explained below.

Narasimhan relates to a personalized couponing system that has a coupon server that provides coupon offers remotely to users based in part on an analysis of their user profiles. The user profiles include information such as income, family information, birthdays and anniversaries, special interests, product preferences, autos owned, and “type of residence”. The reference also states that the server may target certain promotions to certain users based on factors such as income, product preferences, “geographic location”, and the like (page 3, paragraph 26). It is not clear from this language what Narasimhan intended when they stated that geographic location is a factor for coupon targeting. However, later in the reference, an example is given that “a particular reward (coupon) may be provided to all system users, all male systems users, *system users having a particular zip code range* . . . (page 4, paragraph 40). Reading the reference as a whole, it may only be reasonably interpreted to teach that coupons are targeted to users that live in a certain area (users having a “particular zip code range”) but does not teach providing coupons to intended travel destinations (or geographic locations), as presently claimed. Notably, the present claims require that the coupon(s) generated by the server be limited to items *at the geographic location associated with the user* (i.e. in the user profile). Although Narasimhan teaches that coupons are targeted to users in certain locations (zip codes), Narasimhan does not appear to teach that those coupons have any *limitations as to items in that geographic location* as presently claimed. For example, in Narasimhan, all males in zip code 99101 may get coupons for toothpaste, but the coupons appear to be usable anywhere (*use not limited geographically – just distribution performed geographically*).

The Examiner cites paragraphs 40 and 53 as teaching the claimed limitation “wherein said coupon is limited to use by the user identified in the user profile data record for items at the geographic location associated with the user” (Office action, page 3). However, paragraph 40 merely states that “a particular reward (coupon) may be provided

to all system users, all male systems users, *system users having a particular zip code range* . .” As discussed above, this may teach targeting coupons to users in certain areas (zip codes) but it does not teach that those coupons are “*limited* to use by the user identified in the user profile data record *for items at the geographic location associated with the user*” as presently claimed. Moreover, paragraph 53, also relied on by the Examiner, merely states the following:

[0053] Preferably, the reward device 212 determines that a reward is to be issued only if: (1) the account identifier 120 in the record 208b is for an account of an identified system 100 user, as noted in the user profile data database 116 or the user account database 132; (2) the identified user has one or more identified available rewards stored in the available reward database 118; (3) at least one of the identified available rewards is relevant based on information in the record 208b; and (4) information from the record 208b indicates that the conditions for the identified relevant available reward have been met by the identified user. Of course, one skilled in the art will recognize that other steps may be taken in determining whether a reward should be issued without departing from the spirit and scope of the present invention.

It is unclear from this part of the specification relied on by the Examiner how Narasimhan teaches that the generated coupons are “*limited* to use by the user identified in the user profile data record *for items at the geographic location associated with the user*” as presently claimed.

In addition, the ambiguous passage provided at page 7, paragraph 61 (but not relied on by the Examiner) that the user may indicate that he wishes to be presented with promotions from a “specific geographic area” only leads to one to speculate what is meant, and it does not teach or suggest the Applicant’s invention as claimed wherein the generate coupons are “*limited* to use by the user identified in the user profile data record *for items at the geographic location associated with the user*”.

Furthermore, the Applicant has clarified the present claims by specifying in the amendment that the generated coupon(s) are distributed to the user for subsequent redemption when purchasing the item associated with the coupon from the coupon offering entity at the geographic location associated with the user, *whereby the coupon offering entity is provided with the identification of the user redeeming the coupon redeeming the coupon*. This is not taught in the cited reference, and Narasimhan, in fact, teaches away from this feature of the present application. Narasimhan provides an automatic purchase reward system that allows a user to obtain purchase rewards without requiring additional effort beyond that which is likely already expended in the course of a normal purchase (page 1, paragraph 6). Narasimhan teaches that a reward storing device stores the reward (coupon) selected by the user. The record of the available reward is stored in the database in connection with the user profile (page 1, paragraph 8). The reward is issued to the user upon his presentation of a predetermined account identifier (such as a credit card) to a merchant in connection with the purchase but only after the transaction has been completed. The account identifier is used by the system to ascertain if there is a reward available for that user in the profile storage. If there is a stored reward, then subsequent a credit is issued accordingly based on the amount of the reward (pages 1-2, paragraph 10). Thus, the user is not required to handle a tangible coupon (a supposed advantage of the system) since the system relies on looking up the user's profile (associated with his credit card number, for example), and in fact the user is unable to obtain a tangible coupon in this respect. This allegedly makes for a seamless redemption process. According to Narasimhan, the accounts are settled later on between the computers in the system.

Since there is no tangible (e.g. paper) coupon generated in this prior art system (it is all done in a back-office manner), then the merchant (vendor) never knows if any particular user is redeeming a coupon at the time of the item purchase. This is underscored by Narasimhan at page 5, paragraph 51:

In the present invention, a participating vendor 202 will likely *not know which customers are redeeming available rewards*. Moreover, it is to be expected that a vendor 202 will create transaction records 204 in connection

with both available reward purchases and non-available reward purchases (e.g., traditional credit card transactions and the like), especially if the account identifier 120 is a traditional credit card account identifier and the transaction record 204 is a traditional transaction record. Accordingly, both reward transaction records (i.e., transaction records 204 for which reward are to be provided) and non-reward transaction records will be periodically submitted by the vendor 202 for receipt by multiple account providers 210. ***Since the vendor 202 will not know which transaction records 204 are reward transaction records***, it is preferable that formatted transaction records 208b be created for all submitted transaction records 204 from each participating vendor 202, and that the reward device 212 determine which formatted transaction records 208b are reward formatted transaction records.

Thus, it is impossible for the vendor/merchant to know which users are redeeming coupons since the crediting of the reward amount is done in a behind-the-scenes manner. While this may provide some advantages to Narasimhan, it results in a system that would be unworkable per the present claims. That is, the Applicant's claims require that the coupon that is generated is distributed to the user for use in a subsequent redemption when purchasing the item from the coupon offering entity, such that the coupon offering entity is provided with the identification of that user redeeming the coupon. Since Narasimhan never distributes the coupon to the user (the coupon data is merely stored offline for later analysis with respect to a transaction that has already taken place), Narasimhan does not anticipate nor render obvious the claimed invention.

Providing the identification of the user to the redeeming merchant is advantageous since it gives the merchant an opportunity to provide certain advantages to that redeeming user at the time of the transaction. For example, in the present invention, the user would provide the tangible coupon to the merchant at the time of the transaction, and the merchant may determine that the user is a new customer and give certain additional discounts, or he may determine that the user is a returning customer and give certain other additional discounts, etc. Thus, providing a physical coupon to the user so he uses it to redeem his coupon during the time of the transaction and thus have the merchant learn his identity via the coupon, as opposed to the back-office, behind-the-scenes,

reward given transparently *after* the transaction has occurred as in the prior art) is not disclosed or suggested. Narasimhan teaches away from the claimed invention as described herein.

Narasimhan mentions that a printer may be used by the user to print a shopping list including the selected product or service (or vendor). The printer may also print “promotion-related information including maps, addresses, telephone numbers, and the like” (see page 4, paragraph 41). However, the method of using the reward remains the same – the user is only *given a credit after the transaction is completed* in an anonymous fashion with the merchant, who *does not know* that the consumer is making the purchase with (and as a result of being provided with) an incentive coupon. This is not related whatsoever to the invention as presently claimed wherein the user is provided with a tangible coupon that bears his identification and which is provided to the merchant at the time of the transaction so that the merchant is aware of the identity of the redeeming user and the fact that the user is making a coupon redemption for that transaction. Thus, the use of a printer in the prior art Narasimhan reference is not relevant to the present invention as claimed.

In addition, Applicant has added new claims 97 and 98, which recite that the coupon offering entity is also provided with the identification of those users for whom coupons have been generated (but not necessarily redeemed). In the base independent claims the coupon offering entities are aware of the users that redeem coupons, but these new dependent claims provide that the coupon offering entities will know the identities of those who get the coupons, even if they do not redeem them. This is disclosed, for example at page 24 (and other portions) of the original specification, thus no new matter has been added. This important feature provides that the coupon offeror will know who has requested his coupons as well as who has actually redeemed them, which is important information useful in subsequent targeting efforts, marketing, etc. Narasimhan does not teach this and these claims are therefore patentable over the cited references.

The remaining pending claims all depend from either claim 41 or claim 69 and thus incorporate all of the limitations as discussed above. Accordingly, these dependent claims are likewise patentable for at least the same reasons discussed above.

In sum, the prior art Narasimhan reference relied on by the Examiner relates to providing a purchase *reward* after and *only after* the associated purchase transaction has been consummated anonymously with the merchant, such that the merchant is *unaware* that the user has been driven to his store by the reward system, wherein the reward is a credit to an account that is associated with the user. The Applicant's invention, on the other hand, provides (*inter alia*) a mechanism for driving consumers to particular merchants in particular geographic locations and providing a redemption opportunity *at the time of the sale* such that the merchant has full knowledge of the identity of the consumer and thus that he has been driven there by the couponing system.

Therefore, it is respectfully submitted that the pending claims are patentable over the prior art of record. Applicant thus submits that the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of this application.

Respectfully submitted,

/arbarkume/

Anthony R. Barkume
Reg. No. 33,831
Attorney for Applicant

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20 Gateway Lane
Manorville, NY 11949
tel (631) 878-0526
fax (631) 980-7997